For the first time in prosecution, despite two previous actions on the merits, the office action now asserts that claims 4-15 are directed to non-statutory subject matter and the claims are rejected under 35 U.S.C. §101. The rejection is respectfully traversed.

There is no dispute about the patentability of computer software and programmed computers in the law. This is true for computers/software that transform data for specific uses. *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994). In *Alappat*, the PTO took the incorrect position that claims directed to "converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means" did not meet §101. *Id*. The Federal Circuit reversed the Board's decision, noting that such a data conversion is not properly characterized as an "abstract idea,"

The Examiner indicates that the present invention can be characterized as abstract because it can be implemented by "the mind of a person or by the use of a pencil and paper". The "pencil and paper" test is part of the incorrect so-called Freeman-Walter-Abele (see, e.g. *Application of Walter*, 618 F.2d 758, 764 (BPAI 1980)(discussing the "paper and pencil test") which, as instructed by MPEP, is not the law to be applied. See, MPEP §2106 "Office personnel should no longer rely on the Freeman-Walter-Abele test to determine whether a claimed invention is directed to statutory subject matter. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998) ("After *Diehr* and *Chakrabarty*, the Freeman-Walter-Abele test has little, if any, applicability to determining the presence of statutory subject matter."

In any event, the analysis performed in the office action overlooks many claim features that clearly establish the statutory subject matter of the claims. The invention concerns electronic document classification and handling, which is the subject of many patents including the patents discussed in the "prior art" section of the instant application. There are entire classification sections that concern the general nature of document classification and selection, and the patents in the prior art section well illustrate that claims directed to methods for document classification and selection by software or computers are patentable.

Regarding the "pencil and paper" analysis (which is not the correct test), even that fails upon a look at the claim language. Claim 1, for example, has a "downloading component". Downloading is clearly a computer performed step. In claim 1, forming training data and creating profiles from training data are clearly computer related in a method that is for "automatically a associating quality value" to an item of data. Claims 16 and 25 include "computer implemented steps", which, by definition, are not performed with "pencil and paper". Claim 28 is a system, and includes "a computer system", an "access device" and a number of positive means plus function elements that are necessarily interpreted in accordance with the computer structures disclosed in the specification.

Claim 1 stands rejected under §112. The rejection is respectfully traversed. The basis for the rejection is that "the term 'profile' was being used before it was created". This apparently is a reference to the order of claim steps, but in this system claim, the parts of the system are specified and related and there is no order required by the claim. The fact that the learning component is listed after the classifier component does not, in any way, imply that the "profile" gets used before its creation. The claim does not so state, and if the rejection is maintained, further explanation is requested.

With the previous amendments, and based upon an interview, Applicant had incorporated the quality requirement of dependent claims such as claim 9 into each of the independent claims. Agrawal, as discussed in the interview and in the previous response, is limited to subject matter topical arrangements. The quality in the present application, as previously explained, is not a topic label. Agrawal only discloses a document organization by topic.

Now, the Examiner rejects the claims under §103 in view of Agrawal and Suchter. The rejection is respectfully traversed.

As a first point, the combination is traversed as lacking motivation and support. The stated reason for the combination is that it "would provide the user more accurate result in the search process". This stated reason is inappropriate as it could be used to combine any two references in the art. Such generic statements are not proper evidence of motivation.

There must be an actual teaching that relates to the specific references at hand to suggest their combination to one of ordinary skill in the art. "More accurate results" are a goal in any database/search engines. As such, the stated motivation is improper.

The combination also ignores the fact that Agrawal specifically teaches away from the present claims, as has been discussed, because Agrawal is concerned with Topic organization of documents. As is clearly stated in the field of the invention of the '575 patent, the disclosure in the '575 patent is concerned with a "system and article of manufacture for organizing and indexing documents by topic." C1, L19-20. All of the testing, and classifying of documents discussed in the '575 patent concerns the topics of the documents being tested. As stated in the very portion of column 10 cited by the examiner, "Before the system can analyze the topics of new documents, the system is provided with examples of documents belonging to given topic(s). Given a topic hierarchy (taxonomy), system training is performed by providing an initial collection of documents for which classifications are known in advance. With reference to the block diagram of a training system 30 of FIG. 3, this may be accomplished, for example, by collecting a number of documents 32."

The new reference Suchter does not make up for this deficiency, as Suchter is directed to organization by topics, as well, which are referred to as categories. Table 1 in column 6 shows the example categories.

With regard to claims 1, 4 and 16, the examiner asserts that Suchter suggests replacing Agrawal's topic driven system with quality, particularly the claim 4 "low level features" that are listed, and the claim 16 quality value that must be interpreted as not related to a topic category. The citation to column 11 in Suchter does not meet the claim requirements or suggest modification of Agrawal. In Column 11, the user that received a document belonging to a category rates the "quality" of the relationship of the document to that category. The default rating is a "3", which is "good" and may be changed by the user. C11, L40-66. This is still a topic related assessment, with the "quality" in Suchter indicating a user's feeling about whether the document was properly in a particular topic category. This

is clearly not the low level features discussed in claim 4. It is also not any form of an automatic determination of quality, as required by any of the independent claims. Suchter simply assigns a default "quality" of a document relating to a topic category and lets users change it.

In claim 25, the labels are explicitly defined as designating "level of quality, interestingness, appropriateness, timeliness, humor, style of language, obscenity, sentiment, or any combination thereof." The "categories" or "topics" labels pointed to by the examiner in Agrawal concern topics, e.g. business, recreation, science, etc. See, FIG. 2. Similarly, in Suchter, the categories concern, for example, "Aquatic Life and "Beaches" (Table 1). The claim 25 requirement is also specified in dependent claim 30 (which depends from independent claim 28), and forms a basis for a separate traversal of the rejection of claim 30.

Regarding claim 28, the classifier means automatically associates a value that is indicative of the qualitative nature of the data. As discussed above, the topics and statistics of the '575 patent and the categories of Suchter do not concern the qualitative nature of data. No "quality value" consistent with claim 28 is determined by Sucther. Instead, the "quality" is an arbitrary value "3" that can be changed by a used, and only concerns how well a document matches a topic category. C11, L40-65.

All of the positions taken in the office action therefore overlook the clear definition of Suchter's "quality value", which is "quality value that indicates how closely the one of the electronic documents matches the selected category"; See, claims 3 and 18 of Sucther; See also column 11, lines 41-46. Sucther, despite using the term "quality value" is completely concerned with a topic organization. As has been discussed before, while the invention may complement a topic based document organization, the methods and systems for classification that are claimed are not directed to selecting and classifying documents based upon topic.

For all of the above reasons, reconsideration and allowance is requested. If the Examiner has any questions, the Examiner is invited to contact the undersigned attorney.

Respectfully submitted,

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